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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,325	07/10/2003	Fredrik Stenmark	9342-100	2825
54414 7590 08/04/2009 MYERS BIGEL SIBLEY & SAJOVEC, P.A. P.O. BOX 37428 RALEIGH, NC 27627				
EXAMINER				
DAO, MINH D				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/617,325

Applicant(s)

STENMARK, FREDRIK

Examiner

MINH D. DAO

Art Unit

2618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10, 17, 21, 22, 24-33 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 4, 9, 18-20, 23, 34, 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/13/08.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 04/20/09, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Duc Nguyen/

Supervisory Patent Examiner, Art Unit 2618.

Response to Arguments

2. Applicant's arguments in the Appeal Brief filed 04/20/09 with respect to the 102 rejection(s) of claim(s) 1-38 under Klein et al. (US 2002/0177410) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Aerrabotu et al. (US 2004/0199914).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-8, 1017, 21, 22, 24-33, 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Aerrabotu et al. (US 2004/0199914).

Regarding claim 1, Aerrabotu teaches a method of transferring data from/to an electronic device comprising: transferring data from/to an electronic device when information used to register the electronic device with a wireless communications network is absent from the electronic device (see [0016]. The ability to contact the IMSI when the SIM that is not inserted in the mobile device arrives at the limitation of the claim).

Regarding claim 2, Aerrabotu teaches determining that the SIM is absent from the electronic device; and determining if a transfer mode is enabled to allow transferring data while the SIM is absent from the electronic device (see [0032, 0033]).

Regarding claim 3, Aerrabotu teaches transferring data if the transfer mode is enabled and blocking transferring data if the transfer mode is disabled (see [0016]). The making or not of the call by the user of the mobile the device arrives at the limitation of the claim.).

Regarding claim 5, Aerrabotu teaches the step of transferring comprises transferring the data using a first communications channel that is separate from a second communications channel used to register the electronic device with the communications network (see [0016-0032, 0033]. The initiating of the call and communication with the emergency facility after the call has been established would take a control channel (to initiate) and voice channel (to talk) to perform).

Regarding claim 7, Aerrabotu teaches the electronic device comprises a mobile cellular radiotelephone configured to register in a Global System for Mobile telecommunications compliant communications network (see [0016, 0032, 0033]).

Regarding claim 8, Aerrabotu teaches determining, in the first electronic device, that a SIM used to store the information is absent therefrom; determining if a transfer mode is enabled for the first electronic device to allow the transfer of data from/to a second electronic device while the SIM is absent; and transferring data from the first electronic device or receiving data from the second electronic device responsive to determining

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that the transfer mode is enabled for the first electronic device (see [0016, 0032, 0033].

The mobile device and the network read on the first and second electronic devices of the claim).

Regarding claim 11, Aerrabotu that the data comprises data stored in non-volatile memory of the electronic device (see [0023]).

Regarding claim 12, Aerrabotu teaches that the data comprises **at least one of** contact information, schedule information, to-do information, e-mail information, web information, image information, audio information, and video information (see [0016, 0032, 0033].

Regarding claim 13, Aerrabotu teaches that the data comprises excess data having a size that exceeds an unused storage capacity of the SIM because there must be cases where the amount of data that the phone of Aerrabotu would transfer or exchange with its destination is larger than the unused storage of the SIM card.

Regarding claim 14, Aerrabotu teaches that the electronic device comprises a unitary mobile cellular radiotelephone (see [0016, 0032, 0033]).

Regarding claim 15, Aerrabotu teaches a processor circuit configured to allow transfer of data from/to the electronic device when information used to register the electronic

device with a wireless communications network is absent from the electronic device (see [0016, 0032, 0033]. The system of Aerrabotu must include a processor to implement the steps in fig. 3.).

Regarding claim 16, Aerrabotu teaches that the processor circuit is configured to determine whether the SIM is present or absent from the electronic device, the electronic device further comprising: a registration circuit configured to register the electronic device with the communications network responsive to the processor circuit determining that the SIM is present; and a data transfer circuit configured to transfer data from/to the electronic device responsive to the processor circuit determining that the SIM is absent and a transfer mode is enabled to allow transferring data while the SIM is absent (see [0016, 0032, 0033]. also see reasons for rejections of claims 15 above.).

Regarding claim 17, the claim includes the limitation as that of claims 1, and 3, therefore is interpreted and rejected for the same reason set forth in the rejection of claims 1 and 3.

Regarding claim 21, the claim includes the limitation as that of claim 7, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 7.

Regarding claim 22, the claim includes the limitation as that of claim 8, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 8.

Regarding claim 25, the claim includes the limitation as that of claim 11, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 11.

Regarding claim 26, the claim includes the limitation as that of claim 12, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 12.

Regarding claim 27, the claim includes the limitation as that of claim 13, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 13.

Regarding claim 28, the claim includes the limitation as that of claim 14, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 14.

Regarding claim 29, the claim includes the limitation as that of claim 15, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 15.

Regarding claim 30, Aerrabotu teaches that the user selectable data comprises at least one of audio information transferred to headphones coupled to the electronic device and video or image data transferred to a display of the electronic device that is selected by a user. In this case, the basic telephone data transferring functions of Klein reads on this limitation on the present invention.

Regarding claim 31, the claim includes the limitation as that of claim 29, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 29.

Regarding claim 32, Aerrabotu teaches a method of transferring data from/to an electronic device comprising: transferring data from/to a first electronic device to/from a second electronic device when a removable Subscriber Identity Module (SIM) that stores information used to register the first electronic device with a wireless communications network is absent from the first electronic device, wherein the first and second electronic devices are associated with a common subscriber to the wireless communications network (see [0016, 0032, 0033]).

Regarding claim 33, the claim includes the limitation as that of claim 8, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 8.

Regarding claim 35, the claim includes the limitation as that of claim 5, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 5.

Regarding claim 37, the claim includes the limitation as that of claim 7, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 7.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 10, 24, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aerrabotu et al. (US 2004/0199914) in view of Klein (US 2002/0177410).

Regarding claim 6, Aerrabotu, as mentioned above, teaches the limitations of claim 1, but does not disclose that the first communications channel is carried over **at least one of** an infrared communications link, a Bluetooth communications link, a USB interface, and an IEEE 802.11 communications link. Klein, in an analogous art, teaches establishment of communication between two mobile terminals capable of connecting with each other using Bluetooth communication and UMTS communication (see [0005, 0017]. In this case, it is clear that the Bluetooth link would need a separate channel different from the UMTS network's). This teaching of Klein reads on the limitation of the claim.

Regarding claim 10, the combination of Aerrabotu and Klein teaches transferring the data while a SIM that stores information other than that used to register the electronic device with the communications network is present in the electronic device (see Klein, [0017]).

Regarding claim 24, the claim includes the limitation as that of claim 10, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 10.

Regarding claim 36, the claim includes the limitation as that of claim 6, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 6.

Allowable Subject Matter

5. Claims 4, 9, 18-20, 23, 34, 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 4, 18, 34, Aerrabotu, as mentioned above, teaches the limitations of claims 2, 16 and 33 respectively, but fails to disclose that the determining if a transfer mode is enabled comprises: requesting input to the electronic device; receiving input to the electronic device via an input device associated with the electronic device; and determining if the received input enables transfer mode as specified in the claim.

Regarding claims 9, 23, 38 Aerrabotu, as mentioned above, teaches the limitations of claims 8, 22 and 37 respectively, but fails to disclose a second SIM that stores information used to register the second electronic device with the communications network is absent from the second electronic device while transferring data as specified in the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D. DAO whose telephone number is (571)272-7851. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW ANDERSON can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2618

